

Serial No. 09/718,754  
Group Art Unit: 1638

#### REMARKS

The Examiner is requested to consider the accompanying remarks.

Reconsideration of the present application is respectfully requested.

Claims 1, 2, 6, 11, 17, 21, and 40-43 are in the application for consideration.

Claims 11, 17, 42 and 43 have been cancelled without prejudice. Claims 1, 2, 6, 21, 40 and 41 have been amended to more distinctly point out that which the applicant regards as the invention.

New claims 44 and 45 have been added. Support for the new claims are found in the specification on page 10, lines 14-19.

#### Rejections under 35 U.S.C. §112, first paragraph

Claims 1-2, 11, 17, 21, 40 and 42-43 are rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner states: "Hybridization conditions do not tell you anything about the properties of your sequence they only indicate which sequences have a certain degree of homology based on the hybridization conditions."

Claims 11, 17, 42 and 43 have been cancelled without prejudice. Claims 1 and 21 have been amended and no longer recite hybridization limitations. It is believed the amendments obviate the rejection.

Claims 1-2, 11, 12, 17, 21, 40 and 42-43 are rejected under 35 USC §112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate scope with these claims.

The Examiner states: "... the specification ... does not reasonably provide enablement for claims broadly drawn to a sequence that hybridizes to SEQ ID NO:1 ... or a sequence having at least 65% sequence identity to SEQ ID NO:1."

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Claims 11, 17, 42 and 43 have been cancelled without prejudice. Claims 1 and 21 have been amended and no longer recite sequence identity or hybridization limitations. It is believed the amendments obviate the rejection.

In view of the amendments and remarks, it is submitted that the rejections under 35 USC §112, first paragraph should be withdrawn.

**Rejections under 35 USC §112, second paragraph**

Claims 21 and 40-43 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states: "Claims 21 and 40-43 are indefinite as the open language of the claim is confusing and implies that there is another piece of DNA with regulating characteristics that is operably linked to 'a second nucleotide sequence selected from the group consisting of'. Applicants are requested to amend the language of the claim to read on the elected regulatory element operably linked to a specified DNA sequence". Claims 42 and 43 have been cancelled without prejudice. Claim 21 has been amended to state:

"An expression cassette comprising a promoter and a first nucleotide sequence operably linked to the promoter, wherein the promoter initiates seed-preferred transcription of the first nucleotide sequence in a plant cell, wherein the promoter comprises a second nucleotide sequence selected from the group consisting of: ...."

The language of the claim preserves Applicants right to protection of the claimed promoter sequence operably linked to any nucleotide sequence that can be transcribed.

The claim has also been amended to no longer recite the limitations of hybridization and sequence identity.

It is believed the amendments to the claim clarify the claimed invention and the Examiner's rejection is obviated.

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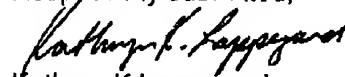
In view of the amendments and remarks, it is submitted that the rejections under 35 USC §112, second paragraph should be withdrawn.

### CONCLUSION

The marked-up version of these amendments is found on a separate sheet attached to this amendment and titled "Version with markings to show changes made." In showing the changes, deleted material is shown in brackets and inserted material is shown as underlined. It is respectfully requested that the amendments be entered.

In view of the above amendments and remarks, Applicants submit that the rejections of the claims under 35 USC §112, first and second paragraphs, are overcome. Applicants respectfully submit that this application is now in condition for allowance.

Respectfully submitted,

  
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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the claims:**

Claims 11, 17, 42, and 43 have been cancelled without prejudice.

Claims 1, 2, 6, 21, 40, and 41 have been amended as follows:

1. (Twice Amended) An isolated [regulatory element] promoter that [is capable of driving] drives transcription in a seed-preferred manner, wherein said [regulatory element] promoter comprises a nucleotide sequence selected from the group consisting of:
  - a) sequences natively associated with, and that drive expression in, DNA coding for maize Jip1 (jasmonate induced protein 1);
  - b) the nucleotide sequence set forth in SEQ ID NO: 1; and
  - c) [a sequence that hybridizes to SEQ ID NO: 1, under highly stringent conditions; and] a sequence comprising a functional fragment of the nucleotide sequence set forth in SEQ ID NO: 1.
  - [d) a sequence having at least 65% sequence identity to SEQ ID NO: 1, wherein the % sequence identity is based on the entire sequence and is determined by GAP version 10 analysis using default parameters.]
2. (Twice Amended) An isolated [regulatory element] promoter that [is capable of driving] drives transcription in a seed-preferred manner, wherein said [regulatory element] promoter comprises a nucleotide sequence natively associated with, and that drives expression in, DNA coding for maize Jip1.

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6. (Twice Amended) An isolated [regulatory element] promoter that [is capable of driving] drives transcription in a seed-preferred manner, wherein said [regulatory element] promoter comprises a nucleotide sequence set forth in SEQ ID NO: 1.
21. (Twice Amended) An expression cassette comprising a [regulatory element] promoter and a first nucleotide sequence operably linked to the [regulatory element] promoter, wherein the [regulatory element] promoter [is capable of initiating] initiates seed-preferred transcription of the first nucleotide sequence in a plant cell, wherein the [regulatory element] promoter comprises a second nucleotide sequence selected from the group consisting of:
- a) the nucleotide sequences set forth in SEQ ID NO: 1;
  - b) [nucleotide sequences having at least 65% sequence identity to SEQ ID NO: 1, wherein the % sequence identity is based on the entire sequence and is determined by GAP version 10 analysis using default parameters;] a sequence comprising a functional fragment of the nucleotide sequence set forth in SEQ ID NO: 1; and
  - c) [a sequence that hybridizes to SEQ ID NO: 1, under highly stringent conditions ; and
  - d)] a nucleotide sequence natively associated with, and that drives expression in, DNA coding for maize Jip1 (jasmonate-induced protein).
40. (Amended) The expression cassette of claim 21, wherein the [regulatory element] promoter comprises a [second] nucleotide natively associated with, and that drives expression in, DNA coding for maize Jip1 (jasmonate-induced protein).

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41. (Amended) The expression cassette of claim 21, wherein the [regulatory element] promoter comprises [a second] the nucleotide sequence [comprising a nucleotide sequence] set forth in SEQ ID NO: 1.

New claims 44 and 45 have been added as follows:

44. An isolated promoter that drives transcription in a seed-preferred manner, wherein said promoter comprises a functional fragment of the nucleotide sequence set forth in SEQ ID NO: 1.
45. The expression cassette of claim 21, wherein the promoter comprises a functional fragment of the nucleotide sequence set forth in SEQ ID NO: 1.